



REMARKS

Status of the claims

Claims 2-7 and 10-17 have been examined. This amendment cancels claims 5, 6, 14 and 15 and amends claims 7, 10 and 11. Claim 7 is amended to correct the dependency in view of the canceled claims. Claim 10 has been amended to conform to Markush practice. Claim 11 has been amended by incorporating the subject matter of claims 6 and 14. The amendment to claim 11 is further supported by the specification at page 4, line 24 and 29-30. No new matter has been added by these amendments.

Rejection Under 35 USC § 112

Claim 10 has been rejected under 35 USC § 112, second paragraph as containing indefinite subject matter. The above amendments place claim 10 in proper Markush format as suggested by the Examiner. Accordingly, the rejection should be withdrawn.

Rejection Under 35 USC § 102(b) over Giese

Claims 3-12 and 15 have been rejected under 35 USC § 102(b) as being anticipated by Giese. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

Claim 11, from which all of the rejected claims ultimately depend, has incorporated the subject matter of claim 14 which was not included

RECEIVED
MAY 22 2000
1700 MAIL ROOM

in the rejection. Thus, since Giese does not disclose “8 to 10g of soy protein isolate per 100g of meat product”, the rejection should be withdrawn.

Rejection Under 35 USC § 103(a) over Giese

Claims 2, 13, 14, 16 and 17 have been rejected under 35 USC § 103(a) as being obvious over Giese. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

The basis for the rejection is that determining the amount of vegetable oil, animal fat and soybean protein to be included in the meat products requires no more than routine experimentation to optimize the conditions. However, the particular parameter to be optimized must be recognized as a variable which achieves a recognized result before the determination of the optimum workable ranges might be characterized as “routine experimentation.” *In re Antonie*, 195 USPQ 6 (CCPA 1977).

In the present situation, the amounts of the components of Giese are not even disclosed, much less recognized as result-effective. For example, Applicants recite in claim 11 that “8 to 10g of soy protein isolate per 100g of meat product” is present in the meat product. Giese fails to disclose any amount of soy protein isolate. Arguing that mere routine experimentation is required overlooks the issue as to whether the experimentation is within the teaching of the prior art. *In re Waymouth*, 499 F2d 1273, 182 USPQ 290 (CCPA 1974) and *In re Saether*, 492 F2d

849, 181 USPQ 35 (CCPA 1974). Since Giese does not motivate one skilled in the art to alter the teachings therein in order to optimize the relevant concentrations of components, it cannot be said that a *prima facie* case of obviousness has been established.

At best this is an “obvious to try” situation. An obvious to try situation exists when a general disclosure may arouse the scientist’s curiosity such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained as certain direction were pursued. *In re Eli Lilly*, 14 USPQ2d 1741 (Fed. Cir. 1990). The principle that “obvious to try” is not the standard for 35 USC § 103 has been repeatedly affirmed by the CAFC. *Jones v. Hardie*, 727 F.2d 1524 (Fed. Cir. 1984); *American Hospital Supply Corp. v. Travenol Laboratories*, 233 USPQ 577 (Fed. Cir. 1984); *Hybritech v. Monoclonal Antibodies, Inc.*, 231 USPQ 81 (Fed. Cir. 1986); *In re Geiger*, 2 USPQ2d 1276 (Fed. Cir. 1987). Such a situation exists here, since as noted above, one would not be able to predict, given the teachings of Giese, that the amounts of the components of the meat products disclosed therein should be optimized according to the parameters instantly claimed.

Further, Giese fails to disclose or suggest that the total plasma-cholesterol and plasma-triglyceride levels can be decreased and that the plasma-HDL-cholesterol levels can be increased in humans upon

consuming a meat product. Absent such a teaching, there is no motivation for the skilled artisan to adjust the component parameters in order to achieve such an effect.

In view of the above distinctions between the instant invention and Giese, and in view of the fact that the subject matter of claim 6, which was not included in the rejection, has been incorporated into claim 11, Applicants request that the rejection be withdrawn.

Rejection Under 35 USC § 102(b) over Bonkowski

Claims 5, 6, 7, 10-12 and 15 have been rejected under 35 USC § 102(b) as being anticipated by Bonkowski. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

Claim 11, from which all of the rejected claims ultimately depend, has incorporated the subject matter of claim 14 which was not included in the rejection. Thus, since Bonkowski does not disclose “8 to 10g of soy protein isolate per 100g of meat product”, the rejection should be withdrawn.

Rejection Under 35 USC § 103(a) over Bonkowski in view of Helmer et al.

Claims 2-4, 7, 10 and 13 have been rejected under 35 USC § 103(a) as being unpatentable over Bonkowski in view of Helmer et al. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

As noted above, Bonkowski fails to disclose or suggest “8 to 10g of soy protein isolate per 100g of meat product”. The teaching of Helmer does not correct this deficiency of Bonkowski. Accordingly, the skilled artisan would not be motivated to alter the meat products of Bonkowski in order to arrive at this feature of the present invention. Absent such motivation, it cannot be said that a *prima facie* case of obviousness has been established with respect to Bonkowski in view of Helmer. Therefore, Applicants request that the rejection be withdrawn.

Rejection Under 35 USC § 103 over Bonkowski

Claims 14, 16 and 17 have been rejected under 35 USC § 103(a) as being unpatentable over Bonkowski. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

The basis for the rejection is the same as that applied in the rejection over Giese. That is, that it would be obvious to the skilled artisan to optimize the amounts of vegetable oil, animal fat and soybean protein through routine experimentation in order arrive at Applicants’ claimed invention.

Applicants disagree with this assumption for the same reasons discussed above regarding Giese. The amounts of the components of Bonkowski are not disclosed, much less recognized as result-effective. Since Bonkowski does not motivate one skilled in the art to alter the teachings therein in order to optimize the relevant concentrations of

components, it cannot be said that a *prima facie* case of obviousness has been established. The rejection is applying an improper obvious to try analysis.

Additionally, Bonkowski can be distinguished from the instant invention in the cholesterol reducing properties. Bonkowski suggests that the cholesterol levels in meats can be reduced, but does not suggest reducing the plasma cholesterol levels in humans. Some studies have suggested that diets limited in cholesterol have produced no significant changes in serum cholesterol levels. In this regard, see Giese, page 100, left column, lines 9-6 from the bottom of the page.

Inasmuch as Bonkowski does not make the presently claimed invention *prima facie* obvious, and in view of the fact that the subject matter of claim 6, which was not included in the rejection, has been incorporated into claim 11, the rejection of the claims under 35 U.S.C. § 103 should be withdrawn.

The present application describes a novel, useful invention. The above amendments and remarks provide for an enabling description of the invention and claims to patentable subject matter. Thus, Applicant respectfully requests allowance of all pending claims.

The Examiner is respectfully requested to enter this Reply After Final in that it raises no new issues. Alternatively, the Examiner is respectfully requested to enter this Reply After Final in that it places the application in better form for Appeal.


Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), the Applicant petitioned for an extension of three months to May 17, 2000 for the period in which to file a response to the office Action dated November 17, 1999 in the concurrently filed Notice of Appeal. The required fee has been paid in connection with the proper filing of this Notice of Appeal.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Laura C. Lutz (Registration No. 43,451) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By:  #82,868
Gerald M. Murphy, Jr.
Reg. No. 28,977
P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

GMM/DC/dab